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new message simultaneously on said display unit in a second display attribute different from said first display attribute when said new message is received by said message receiving unit during the display of said messages.

REMARKS

This response is submitted in response to the Final Office Action dated January 8, 2003, and respectfully requests that the Examiner reconsider the rejection of the claims as set forth therein. In the event that the Examiner determines that the foregoing Amendments do not place the application in condition for allowance, it is respectfully requested that the foregoing Amendments be entered to place the claims in better form for consideration upon appeal.

In the Final Rejection issued January 8, 2003, the Examiner has repeated the rejections of the non-final second Official Action of July 30, 2002.

In the Response Under 37 C.F.R. §1.111 filed April 2, 2002, the applicant amended claims 1, 4-10, 13 and 15-16 to more clearly distinguish between *stored* messages and *new* messages.

In the non-final second Official Action of July 30, 2002, the Examiner changed the grounds of rejection of claims 1, 2, 10 and 11 under 35 U.S.C. § 103(a) to being unpatentable over Bennett et al (US 5,965,569 – filed March 14, 1989 – issued October 23, 1990) in view of either Sone (US 5,793,304 – filed July 16, 1996 – issued August 11, 1998) or Burgan et al (US 6,166,621 – filed January 29, 1998 – issued December 26, 2000) or McLaughlin et al. (US 4,975,694 – filed March 14, 1989 – issued December 4, 1990).

The Examiner likewise changed the grounds of rejection of claims 3 and 12 under 35 U.S.C. § 103(a) to being unpatentable over Bennett in view of either Sone or Burgan et al or McLaughlin et al and further in view of Fennell (US 5,430,436 – filed July 22, 1994 – issued July 4, 1995).

The Examiner also changed the grounds of rejection of claims 4-9 and 13-18 under 35 U.S.C. § 103(a) to being unpatentable over Bennett in view of either Sone or Burgan et al or McLaughlin et al and further in view of Nakajima (US 4,477,807 – filed June 4, 1982 – issued October 16, 1984).

At the outset, prior to addressing the rejections over the prior art in the Final Rejection, the applicant calls to the Examiner's attention that the applicant has amended claims 1 and 10 to recite the limitation --simultaneous display-- of the first and second display attributes.

Specifically, claim 1 has been amended to add the limitation -- displaying simultaneously said new message on said display unit in a second display attribute different from said first display attribute--.

Claim 10 has been amended to add the limitation -- for displaying a new [messages] message simultaneously on said display unit in a second display attribute different from said first display attribute when said new message is received by said message receiving unit during the display of said messages--.

Support for the amendments to claims 1 and 10 is provided by the specification, page 11, line 21, to page 12, line 6, which discloses the following:

“If the latest message is received during the reading of the message #m (104), the display of message #m is interrupted and the latest message is displayed. *The latest message (105) is displayed in a color inversion so that the latest message can be distinguished from the messages which the user has viewed until then.* Thus, the latest message is displayed in a display attribute different from that of the messages which the user has viewed until then. The latest message may be displayed in a highlighted display or in boldface display or by way of varying the typeface.”

The applicant maintains that the foregoing paragraph implicitly discloses simultaneous display of the stored messages with the new messages, with new messages having a different display attribute. Therefore, no new matter has been added.

The applicant has attached hereto a marked-up version of the claims showing the amendments made thereto. It is entitled “Version with Markings to Show Changes Made”.

35 U.S.C. 103(a) Rejections: Claims 1, 2, 10 and 11

Claim 1, prior to the foregoing amendment, generally recited in part in a selective call radio apparatus a method of displaying *stored messages*, which are already received, on a display unit in *a first display attribute* in a message

display mode in response to a display instruction and displaying said *new message* on said display unit in *a second display attribute different from said first display attribute when a new message is received during the display of said stored messages.*

Similarly, claim 10, prior to the foregoing amendment, generally recited in part a selective call radio apparatus comprising a control unit for displaying *new messages on said display unit in a second display attribute different from said first display attribute when said new message is received by said message receiving unit during the display of said messages.*

In the Response to Arguments, the Examiner now asserts that the applicant has argued the references individually whereas the rejections are based on combinations of references. The Examiner refers to *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Circ. 1986) as court decisions affirming the principle that the references must be argued against as a combination. The Examiner asserts that Bennett et al is cited for providing an indication to the user that the new message received during the display mode is not a previously stored message. The other references are then cited for teaching or suggesting first and second display attributes to provide different indications to the user.

In response, the applicant maintains that the applicant argued that neither Bennett nor Sone, nor Burgan, nor McLaughlin, taken alone or in combination, disclose teach or suggest *appearance on the display unit of a first*

display attribute for the stored messages and of a second display attribute for the new messages, when said new message is received by said message receiving unit during the display of said messages, as recited by claims 1 and 10.

The applicant maintains in addition that the applicant argued against Bennett et al as not disclosing what the Examiner asserted Bennett et al disclosed. The applicant argued further that none of the other references disclosed what the Examiner asserted Bennett et al disclosed. Therefore, the applicant did not argue against the references individually but rather as a combination.

The Examiner also states that as part of the applicant's argument, the applicant also argued that Bennett et al do not teach simultaneous appearance of a first display attribute and a second display attribute. The Examiner indicates that this limitation does not appear in the present claims and therefore the argument is not persuasive.

In response to the continued rejections of claims 1, 2, 10 and 11 under 35 U.S.C. § 103(a) to being unpatentable over Bennett et al in view of either Sone or Burgan et al or McLaughlin et al, as noted previously, the applicant has amended claims 1 and 10 to recite generally simultaneous display of new message on said display unit in a second display attribute different from said first display attribute. As a result, claims 1, 2, 10 and 11 patentably distinguish over Bennett et al in view of either Sone or Burgan et al or McLaughlin et al. Consequently, the applicant respectfully requests that the Examiner withdraw the rejections of claims 1, 2, 10 and 11.

35 U.S.C. 103(a) Rejections: Claims 3 and 12

In response to the rejections of claims 3 and 12 under 35 U.S.C. § 103(a) to being unpatentable over Bennett in view of either Sone or Burgan et al or McLaughlin et al and further in view of Fennell as disclosing a highlighted display, the applicant maintains that Fennell does not overcome the deficiencies of Bennett in view of either Sone or Burgan or McLaughlin with respect to claims 1 and 10. Therefore, claims 3 and 12 patentably distinguish over Bennett in view of either Sone or Burgan et al or McLaughlin et al and further in view of Fennell. The applicant respectfully requests that the Examiner withdraw the rejections of claims 3 and 12.

35 U.S.C. 103(a) Rejections: Claims 4-9 and 13-18

In response to the rejection of claims 4-9 and 13-18 under 35 U.S.C. § 103(a) as being unpatentable over Bennett in view of either Sone or Burgan et al or McLaughlin et al and further in view of Nakajima, and the Examiner's assertion that the Abstract of Nakajima et al discloses a paging system where the messages are displayed in a sequential order based upon their arrival and the Examiner's official notice that tracking arrival of time stamps of first in first out (FIFO) memory are both common in the art to track the arrival sequence of messages, the applicant respectfully maintains that Nakajima relates to a technique for storing a received message in a memory. Nakajima does not overcome the deficiencies of Bennett in view of Sone or Burgan or McLaughlin with respect to claims 1 and 10. Therefore, claims 4-9 and 13-18 patentably distinguish over Bennett in view of

Sone or Burgan or McLaughlin and further in view of Nakajima and the Examiner's Official Notice. The applicant respectfully requests that the Examiner withdraw the rejections of claims 4-9 and 13-18.

In view of the foregoing Remarks, the applicant respectfully requests that the Examiner enter this amendment. The foregoing Remarks establish the patentable nature of all of the claims in the application, i.e., claims 1-18. No new matter has been added. It is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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Enclosure (Version with Markings to Show Changes Made)

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Claim 1 has been amended as follows:

1. (Twice Amended) A method of displaying messages in a selective call radio apparatus comprising the steps of:

displaying stored messages, which are already received, on a display unit in a first display attribute in a message display mode in response to a display instruction;

when a new message is received during the display of said stored messages, temporarily stopping the display of said stored messages on said display unit in said message display mode; and

displaying simultaneously said new message on said display unit in a second display attribute different from said first display attribute.

Claim 10 has been amended as follows:

10. (Twice Amended) A selective call radio apparatus comprising:

a display unit;

a storage unit for storing messages;

an operation unit used to input instructions and data;

a message receiving unit; and

a control unit for reading out said stored messages from said storage unit to display on said display unit in a first display attribute in a message display mode in response to a display instruction supplied from said operation unit, for displaying a

new [messages] message simultaneously on said display unit in a second display attribute different from said first display attribute when said new message is received by said message receiving unit during the display of said messages.